



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,179	09/17/2003	Bradley D. Kolar	33836.03.0004	5569
36498 7590 03/12/2009				
Vedder Price PC				
222 NORTH LASALLE STREET				
CHICAGO, IL 60601				
EXAMINER				
STERRETT, JONATHAN G				
ART UNIT		PAPER NUMBER		
3623				
MAIL DATE		DELIVERY MODE		
03/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/665,179

**Applicant(s)**

KOLAR ET AL.

**Examiner**

JONATHAN G. STERRETT

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### DETAILED ACTION

1. Currently **Claims 1-47** are pending. This **Final Office Action** is responsive to 29 December 2008.
2. The applicants arguments have been fully considered with respect to the 103(a) rejections, but are moot in view of new grounds of rejection. The applicant's arguments with respect to the 35 USC 101 rejections have been fully considered, but are not persuasive.

The examiner acknowledges the applicant's comments regarding the interviews given but notes that the amended claim limitations are addressed with a new 103(a) rejection below.

The applicant's argue that the claims provide for a transformation of data.

The examiner respectfully disagrees.

Transforming data to a different state or thing does not occur when data is simply manipulated or scored based on a rating of an educational product. The data is still data – it is not transformed. There is no underlying article or materials that is being transformed, only data that is being manipulated, thus the current method claims are still not statutory under 35 USC 101.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-30 and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1, 5 and 21 are directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to another statutory class (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the other statutory class to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

Here, the claimed invention does not transform underlying subject matter to a different state or thing because it merely creates and implements a business model and adjusts reward structures based on performance. Furthermore, the claimed process is not tied to another statutory category, such as a particular apparatus. The claimed invention of selecting objectives, creating and implementing a business model,

measuring performance, and rewarding employees for good performance is capable of being carried out entirely by the human mind. Thus, it is not tied to another statutory category and is not patentable under § 101.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 USC. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-10, 13-20, 31-33 and 43-46** are rejected under 35 USC. 103(a) as being unpatentable over **Lawlis**, et al.; "A Formal Process for evaluating COTS Software Products", (C) 2001 IEEE, Computer, pp.58-63 (hereinafter **Lawlis**) in view of Mamoukaris et al.; "Evaluation of web-based educational systems", 2000, Vol. 1, Academy of Business Education, pp.1-6 (hereinafter **Mamoukaris**).

Regarding **Claim 5**, Lawlis teaches

**An educational product evaluation method comprising:**

Page 58 column 1 para 1,

**storing business goal rule data;**

Page 58 column 1 para 3-4, the RCPEP is a stored evaluation technique for evaluation of COTS software products.

**generating a plurality of educational product alignment values for each of a plurality of educational products, based on a plurality of associated plurality of educational product evaluation category values and the stored business goal rule data;**

page 60 Figure 2, values for a plurality of products are generated, based on a plurality of categories and the rules for applying those categories to the products.

**generating, for each educational product of interest, an overall business alignment value based on the plurality of educational product alignment values; and**

page 60 Figure 2, the sum total of each of the plurality of scores (i.e. an overall value) based on the single values.

**generating an educational product summary containing at least the overall business alignment value for each of the plurality of educational products.**

Page 60 Figure 2, the product summary scores for products A, B thru Z (bottom of table) is generated for each product.

Lawlis does not teach where the business goal rule data corresponds to a business organization's goals with respect to employee training. However, the recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms

of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ' 2106.

Official Notice is taken that it is old and well known in the art for business organization's to have goals with respect to training.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lawlis to include measuring educational products based on goals that an organization has with respect to training, because it would have provided a predictable result through evaluating software products against an organization's goals for training.

Lawlis does not teach where the educational values are **for indicating the alignment of each educational product to said business organization's goals with respect to employee training;**

**Wherein each educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area;**

**Wherein said plurality of educational products includes at least one of an instructor lead face to face course, a self-study course and a virtual course**

Mamoukaris teaches:

where the educational values are **for indicating the alignment of each educational product to said business organization's goals with respect to employee training;**

**Wherein each educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area;**

page 4 chart shows participant rating of evaluation of various tools as to their effectiveness in key educational areas (e.g. platform independence, course restrictions, reports of user's progress).

**Wherein said plurality of educational products includes at least one of an instructor lead face to face course, a self-study course and a virtual course**

Page 3 under section 3, Mamoukaris is evaluating virtual courses.

Lawlis and Mamoukaris both address issues with evaluating software (Lawlis is evaluating general COTS software and Mamoukaris is evaluating aspects of software for distance learning), thus they both are analogous art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lawlis, where various software aspects are scored and tallied, to include the teachings of Mamoukaris regarding evaluation of software aspects of distance learning tools, because it would have provided a predictable result



in using known numerical techniques of scoring to evaluate the software aspects of distance learning tools.

Regarding **Claim 6**, Lawlis teaches

**The method of claim 5 wherein storing the business goal rule data includes storing data representing rules defined for a plurality of desired business goals wherein the business goal rule data represents at least one of: a strategic importance level, a cost effectiveness level and an educational product impact level.**

Figure 2, "Runs on appropriate platform" is a strategic importance level.

Regarding **Claim 7**, Lawlis teaches

**The method of claim 5 including generating the educational product summary to contain the plurality of educational product alignment values corresponding to each of the plurality of educational products.**

Page 60 Figure 2, the summary contains the product alignment values corresponding to each of the products A, B...Z.

Regarding **Claim 8**, Lawlis teaches

**The method of claim 7 including presenting the educational product summary for a user.**

Figures 2 and 4 teach presenting the product summary to a user.

Regarding **Claim 9**, Lawlis teaches

**The method of claim 5 including generating the plurality of educational product alignment values for each of a plurality of educational products based on received weighting values associated with each of the plurality of educational product alignment values.**

Page 60 figure 3, each of the ratings assigned to particular metric (i.e. product alignment values) is based on importance weightings for each of the individual metrics.

Regarding **Claim 10**, Lawlis teaches

**The method of claim 5 wherein generating the plurality of educational product alignment values for each of a plurality of educational products includes generating a strategic importance alignment value, a cost effectiveness alignment value and an educational product impact alignment value.**

Page 60 Figure 2, "runs on appropriate platform", i.e. a strategic importance alignment value; "Supports appropriate configurations", i.e. a cost effectiveness alignment value; and "Online Help Context Sensitive", i.e. an educational product impact value.

Regarding **Claim 13**, Lawlis teaches

**The method of claim 5 wherein storing the business goal rule data includes providing a cost threshold input interface operative to receive cost thresholds for different types of educational products.**

Page 59 column 1 para 1 and 2, the entering of data into a matrix for scoring (i.e. an interface for receiving data).

Regarding **Claim 14**, Lawlis teaches

**The method of claim 5 wherein storing the business goal rule data includes providing an educational product time input interface operative to receive time threshold data for different types of educational products.**

Page 59 column 1 para 1 and 2, the entering of data into a matrix for scoring (i.e. an interface for receiving data).

Regarding **Claim 15**, Lawlis teaches

**The method of claim 10 including generating a cost effectiveness alignment value matrix containing at least description data relating to different cost scores and different corresponding time scores.**

Page 60 column2 – the use of a matrix shows how different scores in different categories (i.e. cost and time) relate to each other.

Regarding **Claim 16**, Lawlis teaches

**The method of claim 7 including generating the education product summary to include corresponding description data for each educational product and for each educational product alignment value for each educational product.**

Page 62 Figure 4, the legend in the chart describes description data (i.e. product names) and illustrates the value for each chart.

Regarding **Claim 17**, Lawlis teaches

**The method of claim 5 including generating an overall business alignment value range graphic element containing sub ranges corresponding to different degrees of alignment with corresponding business goal rule data.**

Figure 4(a), a graphic element with subgroups containing different degrees of alignment with the subrankings.

Regarding **Claim 18**, Lawlis teaches

**The method of claim 5 including generating a graphic element illustrating educational product penetration compared to a group of educational products.**

Figure 4(c), the different products are compared to each other with respect to various criteria.a

Regarding **Claim 19**, Lawlis teaches

**The method of claim 5 including generating an educational product content redundancy map indicating which educational products include subject matter that is pertinent to multiple strategic subject categories.**

Figure 4-c, shows which products include various subject matter rankings, i.e. pertinent to multiple strategic subject categories.

Regarding **Claim 20**, Lawlis teaches

**The method of claim 10 wherein generating the educational product summary includes providing a graphic element representing the educational product summary including visual coding of the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value.**

Figure 4, the shading of the graph elements provides visual coding of the various categories being ranked.

**Claims 1-4, 31-33 and 43-46** recite similar limitations to those addressed by the rejection of **Claims 5-10 and 13-20**, and are therefore rejected under the same rationale.

Furthermore regarding **Claims 31-33 and 43-46**, Lawlis teaches the limitations recited by the apparatus, however Lawlis does not explicitly teach the method being performed on a computer apparatus with memory and various generators as claimed.

However, Official Notice is taken that it is old and well known to perform method steps, such as taught by Lawlis using a computer. This makes the method steps faster and more efficient, since they are running on a computer.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lawlis to include performing the method steps on a computer, since it would make the performance of these steps faster and more efficient since they are running on a computer.

7. **Claims 11, 12, 21-30, 34-42** are rejected under 35 USC. 103(a) as being unpatentable over **Lawlis** in view of **Mamoukaris**, in view of **Murphy**, Cheryl; "An evaluation format for "open" software tools", 1995, Computers in Human Behavior, v11, No. 3-4, pp.619-631, (hereinafter **Murphy**) and further in view of Matthew Owen Howard, R Dale Walker, Patricia Silk Walker, Richard T Suchinsky; "Alcohol and drug education in schools of nursing", Journal of Alcohol and Drug Education. Lansing: Spring 1997. Vol. 42, Iss. 3; pg. 54, 27 pgs, (hereinafter **Howard**)

Regarding **Claim 11**, Lawlis teaches using a composite scoring system to rate a software product using various input values, as discussed above, and Lawlis teaches:

**The method of claim 10 wherein;**  
**the educational product impact alignment value is based on at least**  
**participant rating data and usage data associated with the educational product**

Lawlis further teaches a strategic importance alignment value based on a strategic importance priority level data of an educational content area (see page 60 Figure 3 – adequacy of specific analysis is data of an educational content area).

Lawlis does not teach where the input values are based upon  
**course hours for the educational products associated with the educational**  
**content area**  
**the cost effectiveness alignment value is based on at least a number of**  
**hours per educational product and a cost of the educational product; and**

Murphy teaches where the cost of a product as an input factor is important when rating a product (page 624 para 1 under “Cost Effectiveness”).

Murphy teaches on page 1 that considering cost is important when considering a software product for higher education (page 619 para 1). Murphy addresses rating software thus Murphy and Lawlis are analogous art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lawlis to include rating software based on cost, as taught by Murphy, because it would improve the software rating by taking into account a cost evaluation as an input factor.

Lawlis and Murphy do not teach using course hours associated with the educational content and number of hours per educational product as a rating input.

However, the idea of associating course hours with educational content is old and well known as a rating or measuring input as shown by Howard. Howard teaches the using of course hours associated with educational content as a way to measure the importance of the course in a student's overall curriculum (see page 59 para 2, the amount of time, i.e. course hours, is used to measure the proportion of time spent in teaching. The use of hours to measure the importance of an instructional course provides a predictable result because it is used in comparison to the total number of hours of instruction.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lawlis and Murphy, regarding measuring the cost of an educational software product to include where the measurement is based on the a number of hours per educational product and course hours for the educational products



associated with the educational content area, because it would include a known way of measuring educational aspects by taking into account the hours spent on those educational aspects and thus provide a predictable result through the application of a known metric known in the art.

Regarding **Claim 12**, Lawlis teaches

**The method of claim 11 including presenting a content area importance table that visually differentiates each strategic importance priority level data for each educational content area.**

Page 60 Figures 2 and 3 visually differentiate the data for each software rating area.

**Claims 21-30 and 34-42** recite similar limitations to those addressed by Lawlis and Mamoukaris above, and are therefore rejected under the same rationale.

Furthermore regarding **Claims 34-42**, Lawlis and Mamoukaris teaches the limitations recited by the apparatus, however they do not explicitly teach the method being performed on a computer and using software.

However, Official Notice is taken that it is old and well known to perform method steps, such as taught by Lawlis using a computer and software. This makes the

method steps faster and more efficient, since they are running on a computer and encoded in a software program.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lawlis to include performing the limitations on a computer with software, since it would make the performance of these steps faster and more efficient since they are running on a computer.

Furthermore regarding, Lawlis does not explicitly teach a computer interface per se and a display that presents the output information.

However, Official Notice is taken that providing these elements on a computer are old and well known for the purpose of making the interface with the computer easy to use.

It would have been obvious to modify the teachings of Lawlis to include where the performance of his various steps include a display and interface for entering and seeing the result of the data processing, because it would make the interaction with the computer in performing of the method steps easy to use.

8. **Claim 47** is rejected under 35 USC 103(a) as being unpatentable over **Lawlis** in view of **Mamoukaris** and further in view of Richard B. Freeman; "Occupational Training

in Proprietary Schools and Technical Institutes", The Review of Economics and Statistics, Vol. 56, No. 3 (Aug., 1974), pp. 310-318. (hereinafter **Freeman**).

Regarding **Claim 47**, Lawlis and Mamoukaris teach collectively providing an evaluation of various aspects of software. Lawlis teaches constraints (i.e. business goal rule data) for evaluating software where those constraints provide evaluation of certain metrics where the evaluation is based on a numerical threshold. Lawlis and Mamoukaris do not teach where the constraints (i.e. the business goal rule data):

**includes at least a course duration limitation limiting the number of days a week an employee can participate in a course given required job related activities.**

Freeman teaches the concept of limiting the number of days a week an employee can participate in a course given required job related activities (see page 312 column 1 para 2, here Freeman discusses the limitation that schools place on courses for those who are working (i.e. given their required job responsibilities). Freeman teaches that this is a quantifiable measure for those who are working and going to school (see footnote on same page). (The examiner notes that Freeman teaches in different hours per week per student, rather than number of days, but Official Notice is taken this difference would be recognizable to one of ordinary skill in the art at the time of the invention as an obvious variant of the hours per week per student).

It therefore would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lawlis and Marmoukaris, regarding using quantifiable metrics to measure educational products, to use a measure of course duration limitation limiting the amount of time that a student can participate in a course as a quantifiable metric, because it would have provided a predictable result in measuring aspects of an educational course.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

Quinn, CN, "Pragmatic Evaluation: Lessons from Usability", 1996, retrieved from the web at: <http://www.ascilite.org.au/conferences/adelaide96/papers/18.html>.

Wingate, Lori; "The Evaluation Checklist Project: The Inside Scoop on Content, Process, Policies, Impact and Challenges", November 4, 2000, Western Michigan University, pp. 1-12.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 3-9-09

/Jonathan G. Sterrett/  
Primary Examiner, Art Unit 3623